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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,173	01/27/2000	Hideki Ito	2298/3	9525

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KENYON & KENYON
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WASHINGTON, DC 20005-1257

EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,173

Applicant(s)

ITO ET AL.

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10, 14, 15, 19, 20, 24, 25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10, 14, 15, 19, 20, 24, 25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

REPEATED REJECTIONS

1. The 35 U.S.C. 103(a) rejection of Claims 7 – 10, 15, 20, and 25 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390), of record on page 2 of the previous Action, is repeated.

The 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291), of record on page 4 of the previous Action, is repeated.

ANSWERS TO APPLICANT'S ARGUMENTS

2. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 7 – 10, 15, 20 and 25 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reason set forth below.

Applicant argues, on page 2 of Paper No. 27, that Boesch is not germane to the present case because one skilled in the art would have had no expectation of success in increasing film shrinkage in the main shrinkage direction while decreasing shrinkage along the perpendicular direction, which was unexpectedly achieved by the present invention; the shrinkage properties

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cannot be linearly determined according to the proportions of the film components or to the shrinkage determined under different conditions, thus there can be no expectation that the properties of Fukuda could be modified to produce those of the claimed invention.

However, the aspect of increasing film shrinkage in the main shrinkage direction while decreasing shrinkage along the perpendicular direction is not claimed. Furthermore, +as stated on page 3 of the previous Action, Fukuda et al disclose a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds (column 6, lines 50 – 58), and a film having a shrinkage of 20% or less in the direction perpendicular to the main shrinkage direction when the film is put in water at 75 degrees Celsius for 5 seconds (column 6, lines 50 – 58) and teach that shrinkage is selected for the purpose of obtaining close adherence between the label and a vessel (column 6, lines 65 – 68; column 7, lines 1 – 2). Therefore one of ordinary skill in the art would have recognized the utility of varying the shrinkage to obtain a desired range of shrinkage. Therefore, the adherence would be readily determined through routine optimization of shrinkage by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the shrinkage in order to obtain a desired adherence, since the adherence would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Fukuda et al. Furthermore, it is not necessary for the shrinkage properties to vary linearly with the proportions of the film components for the variation of shrinkage to obtain a desired adherence to be obvious to one of ordinary skill in the art.

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Applicant also argues on page 3 that the reliance on optimization is misplaced because the claimed shrinkage properties are not result – effective variables that require optimization. However, as stated above, Fukuda et al teach that shrinkage is selected for the purpose of obtaining close adherence between the label and a vessel, and therefore recognize shrinkage as a result – effective variable.

Applicant also argues on page 3 that it can be understood from the examples in Shibuya et al that by adding polyester elastomer, the cold resistance of Shibuya et al may improve while the gas barrier property may deteriorate.

However, it is unclear why Applicant understands the gas barrier property to deteriorate as Shibuya et al do not specifically teach the deterioration of the barrier property.

Applicant also argues, on page 4, that the films of Shibuya et al have inferior shrinkage properties to that of Fukuda et al, and also comprise polyvinylidene chloride, whereas Fukuda et al disclose polyester – only films; Fukuda et al inherently possesses cold resistance Applicant argues, thus there would be no teaching to improve its cold resistance, which is the purpose of Shibuya et al.

However, as stated on page 2 of the previous Action, Shibuya et al teach a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in a heat shrinkable polyester film (column 3, lines 29 – 41) for the purpose of making a heat shrinkable film having superior gas barrier property (column 3, lines 25 – 28).

One of ordinary skill in the art would therefore have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic

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polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al, which is also a heat shrinkable polyester film. Furthermore, Fukuda et al do not teach the exclusion of components other than polyester.

Applicant also argues on page 4 that Applicant conducted considerable trial and error experimentation to obtain the claimed film, thus a skilled artisan would not have had a reasonable likelihood at successfully combining Fukuda et al and Shibuya et al in a way that would result in a film with superior shrinkage properties.

However, as stated above, teachings of Shibuya et al are only cited to establish that one of ordinary skill in the art would have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin of Shibuya et al in Fukuda et al, which is also a heat shrinkable polyester film, for the purpose of making a heat shrinkable film having superior gas barrier property.

Applicant also argues on page 4 that the claimed adhesive retention is a physical property of the film that can be measured as defined in the claims. However, the definition of a sample of being adhesively retentive if it cannot easily be peeled by hand is clearly a desired result, and furthermore is subject to the opinion of the individual peeling the film as to what constitutes easy removal.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 – 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 – 1498. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

Marc Patterson
Art Unit 1772

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

6/14/04